

REMARKS

Applicant has reviewed the Non-Final Office Action mailed January 29, 2009. Claims 1-5 and 8-18 are amended herein, and no new claims have been added. Thus, claims 1 through 18 remain pending in the application. Applicant hereby requests further examination and reconsideration of the application in view of the following remarks.

Applicant states that no new matter is being added by the amendment of claims 1-5 and 8-18. Support for the amendments may be found throughout the specification of the instant application, more particularly, see paragraphs [0020], [0025], [0026], [0027], [0029] and [0033]-[0035].

Examiner's Remarks/Comments

The Examiner asserts that certain language in the claims, and particularly terms such as “when” and “upon,” suggest or make optional certain recited functions or steps of the apparatuses and methods defined in the claims. It is respectfully submitted that the claims as amended herein positively recite such functions and steps, thus obviating the Examiner's requirement for correction.

Claim Rejection -- 35 U.S.C. §101

Claims 1–18 were rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter, and particularly for containing mixed subject matter in claims 1-5 and 11-15, and for not being in proper Beauregard form in claims 5 and 15. It is respectfully submitted that the claims as amended herein particularly limit the claims in

each case to a single statutory class of invention, and that claims 5 and 15 are in proper form, thus obviating the Examiner's rejection. Applicant therefore respectfully requests withdrawal of the rejection.

Claim Rejection -- 35 U.S.C. §112

Claims 1 through 18 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

First, the Examiner asserts that use of the term "disproportionate" renders the claims indefinite. Applicant respectfully disagrees, as the specification clearly sets forth a standard by which any person of ordinary skill in the art would readily be able to ascertain the requisite degree. More particularly, the specification provides at paragraph [0026]:

When the kiosk starts to service print requests 302, the second output print device will produce a disproportionate amount of production compared to the first output print device. One skilled in the art will appreciate that there are a number of methodologies to have one printer produce more output relative to another printer so that the two printers are not alternating in producing output. The present invention encompasses all of these strategies for producing a disproportionate amount of product between the different output print devices. This disproportionate amount of production in favor of the second output print device proceeds until the first output print device has 2 to 1 ratio of remaining consumable media to the second output print device 304.

Thus, a person of ordinary skill in the art would readily ascertain that the term "disproportionate," as used in the claims, requires a first output print device generating more output than a second output print device so that the two are not evenly alternating in producing output, and so that the first output print device's consumable media is

expended more quickly than the second output print device's media, so as to ultimately achieve a 2 to 1 ratio of consumable media between the two output print devices. Such disproportionate output likewise results in disproportionate use of consumable media (e.g., dye transfer ribbons, paper, material for a protective overcoat laminate, and inkjet cartridges, as described in paragraph [0024] of the specification) among the output print devices. While a precise level of difference in output or depletion of consumable media is not recited, none need be, as any difference that ultimately allows the output print devices to achieve a 2 to 1 ratio in remaining consumable media is sufficient and intended to fall within the scope of the invention. It is, therefore, respectfully submitted that the term "disproportionate" has ample support in the specification to allow a person of ordinary skill in the art to readily ascertain the scope of the invention.

The Examiner next asserts that use of the term "consumable media" renders the claim indefinite. Again, Applicant respectfully disagrees. The specification particularly sets out at paragraph [0024] the following:

The consumable media used by dye sublimation printers includes dye transfer ribbons, paper, and material for a protective overcoat laminate. The consumable media used by inkjet printers includes inkjet cartridges and paper.

Given such clear description in the specification, a person of ordinary skill in the art would readily ascertain the meaning of the term "consumable media" as set forth in the claims, and particularly understand that such term includes the specifically enumerated examples of consumable media noted above and equivalents thereof.

Given the clear description of the terms "disproportionate" and "consumable media" provided in the specification, it is respectfully submitted that the use of such

terms in the claims does not render them indefinite, such that the Examiner's rejection in this regard should be withdrawn.

The Examiner also asserts that claims 1-5 and 11-15 are deficient as hybrid claims. As noted above, it is respectfully submitted that the claims as amended herein particularly limit the claims in each case to a single statutory class of invention, thus obviating the Examiner's rejection. Applicant therefore respectfully requests withdrawal of the rejection.

With particular regard to claims 5 and 15, the Examiner notes that it is unclear what the term "comprising" refers to. Claims 5 and 15 have been amended to remove any such ambiguity.

Next, with regard to claims 6 and 7, the Examiner asserts that "one of ordinary skill in the art would not be able to determine an amount level [of consumable media] when they can not identify the consumable media." As explained above, the specification provides a clear description of such consumable media, such that a person of ordinary skill in the art would readily be able to determine the scope of the claimed invention.

Next, with regard to claims 8 and 16-18, the Examiner asserts that the dependency of claim 8 on claim 5, and of claims 16-18 on presumably claim 15, renders such dependent claims indefinite, and particularly indicates that such dependent claims require programming a dye sublimation, transfer ribbons, paper, or protective overcoat laminate. Such is simply not the case. With regard to claim 5, claim 8 simply narrows specific elements already set forth in claim 5. Moreover, those elements are properly set out in claim 5 – namely, the method performed by the claimed program includes the instruction

of using consumable media (which, in the context of claim 8, can be read as using dye transfer ribbons, paper, and protective overcoat laminate) in each of first and second output print devices, not of programming such consumable media. Similarly, with regard to claim 15, claims 16-18 simply narrow specific elements already set forth in claim 15. Once again, a person of ordinary skill in the art would readily understand the scope of the invention in light the foregoing terms.

Last, the Examiner asserts that “[t]he claim(s) are narrative in form and replete with indefinite and functional or operational language.” While Applicant disagrees with such characterization, the claims as amended herein clearly set forth in each case a single statutory category of invention, in the case of apparatus claims recite only specific apparatus limitations (including specifically configured executable computer instructions), and in the case of method claims recite only specific method steps (including providing particularly configured elements).

In light of the foregoing, it is respectfully submitted that each of claims 1-18 is sufficiently definite, and Applicant therefore requests that the rejection of such claims under 35 U.S.C. 112 be withdrawn.

Claim Rejection – 35 U.S.C. §102

Claims 1, 3-11, and 13-18 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 7,221,465 (“Shimada”). Applicant respectfully traverses this rejection, and requests withdrawal of same.

The Examiner has not set out a *prima facie* case of anticipation, and without the establishment of such a *prima facie* case, the rejection must be withdrawn. The Federal

Circuit has held that “[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.” *W.L. Gore & Assocs. v. Garlock*, 220 USPQ 303, 313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Moreover, “[a]nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) (*citing Connell v. Sears, Roebuck & Co.*, 220 USPQ 193 (Fed. Cir. 1983)). In the instant case, the Examiner cites without comment broad sections of the Shimada reference which, upon even cursory inspection, make no mention or even hint of Applicant’s particularly cited limitations. For instance, each of Applicant’s claims particularly requires (whether by way of an executable computer instruction configured to carry out a specific function or by way of a particular method step) initially causing a disproportionate amount of consumable media to be used in a second output print device compared to a first output print device until the amount of consumable media in the first output print device is in a first preferred ratio to the amount of consumable media in the second output print device, at which point it alternates the usage of consumable media between the two print devices until the second output print device is exhausted. The passages from Shimada cited by the Examiner fail to disclose or even hint at such a feature. Rather, the device of Shimada functions simply to match print characteristics among distinct printers, and particularly adjusts the print characteristics (i.e., color correction data) of one printer to match the print characteristics of another printer. As best described at column 4, lines 1-16 of Shimada, the Shimada device detects a failure in one printer, and then transfers the entire print job elsewhere, adjusting the print

characteristics of the receiving printer to match those of the first printer. It does nothing to detect particular levels of consumable media in the various printers, or to modify the frequency of printing among multiple printers based on desired ratios of consumable media, as is required by each of Applicant's claims. Simply, none of the passages cited by the Examiner in any way suggest such feature. Similarly, the remaining claimed features even further distinguish:

- None of the cited passages of Shimada even suggest using a disproportionate amount of consumable media in the second output print device (after replenishment) until the amount of consumable media in the second output print device is in a second preferred ratio to the amount of consumable media in the first output print device, at which point it again alternates the usage of consumable media between the two print devices, this time until the first output print device is exhausted.

- None of the cited passages of Shimada even suggest using a disproportionate amount of consumable media in the first output print device (after replenishment) until the amount of consumable media in the first output print device again achieves the first preferred ratio to the amount of consumable media in the second output print device, at which point it again alternates usage between the two (and thereafter continuing such processes).

Although the Examiner with broad brush application asserts that such limitations (all of which are found in independent claims 1-5 and 11-15) are found in Shimada, they simply are not, and the Examiner has provided absolutely no explanation of how the distinctive features of Shimada of matching color profiles among distinct printers somehow

“expressly teach” Applicant’s claimed control of the use of consumable media through management of the print frequency of multiple output print devices based on how much consumable media has been used in each. Absent such a showing, the Examiner has failed to make out a *prima facie* case of anticipation, such that the rejection under 35 U.S.C. 102 must be withdrawn.

Claims 6-10 properly depend from independent claims 1-5 and, for all of the reasons stated above, are likewise patentably distinguished. Similarly, claims 16-18 properly depend from independent claims 11-15 and are also patentably distinguished.

Claim Rejection -- 35 U.S.C. §103

Claims 2, 6-10, 12 and 16-18 were rejected under 35 U.S.C. §103(a) as being unpatentable under Shimada in view of U.S. Patent No. 6,148,148 (“Wain”). Again, Applicant respectfully traverses this rejection, and requests withdrawal of same.

The Examiner cites Wain for the sole premise of disclosing a “digital photographic kiosk.” As explained above, Shimada fails to disclose or even remotely suggest Applicant’s claimed features of detecting particular levels of consumable media in the various printers, or modifying the frequency of printing among multiple printers based on desired ratios of consumable media. With regard to claims 2 and 12, such features are affirmatively recited as executable computer instructions embodied on a system controller that forms part of the kiosk. Wain does nothing to cure such deficiencies in Shimada, and the Examiner does not suggest otherwise. Thus, even assuming the Examiner’s combination is warranted, it does not result in Applicant’s

claimed invention, such that the rejection under 35 U.S.C. 130 cannot be sustained.

Applicant therefore respectfully requests withdrawal of same.


Claims 6-10 properly depend from independent claim 2 and, for all of the reasons set forth above, are likewise patentably distinguished. Similarly, claims 16-18 properly depend from independent claims 12 and are also patentably distinguished.

CONCLUSION

In light of the forgoing, reconsideration and allowance of the claims is earnestly solicited. Accordingly, notification to that effect is earnestly requested. In the event that issues arise in the application which may readily be resolved via telephone, the Examiner is kindly invited to telephone the prosecuting attorney, identified below, at (410) 659-6402 to facilitate prosecution of the application.

Respectfully submitted,

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